

REMARKS

The above amendments and following remarks are submitted within the priority period under 37 C.F.R. 1.116 in response to the Final Official Action of the Examiner mailed December 8, 2005. Having addressed all objections and grounds of rejection, claims 1-25, being all the pending claims, are now deemed in condition for allowance. Entry of this amendment and reconsideration to that end is respectfully requested.

The remaining rejections to all pending claims (i.e., claims 1-25) are all associated with prior art rejections based upon U.S. Patent No. 6,604,100, issued to Fernandez et al (hereinafter referred to as "Fernandez") as the primary reference. The structure and mechanisms of "service request/response" are substantially different between Fernandez and all of Applicant's claims.

With Fernandez, as clearly shown in Fig. 1, the User Query (in XML) is generated within an application and transferred from the application to the "SilkRoute" middleware over the communication network 130. The middleware converts the request to SQL and transfers it to the RDMS for honoring. The response to the query is transferred back to SilkRoute for conversion back to an Answer (XML document) which is returned to the application. The only transfer from application 120 is a "User Query" and the only transfer to application 120 is an "Answer".

In Applicant's claimed invention, on the other hand, the service request is generated using a "customized user interface" which is at least in part stored within the same data base management system which honors the service request. Therefore, in order for the user terminal to generate the claimed "service request" using the claimed "customized user interface", it must receive components thereof from the data base management system via the publically accessible digital data communication network. Thus, in Applicant's claimed invention, transfers to the user terminal include "components" of the "customized user interface" as well as the response to the service request.

This feature of Applicant's invention and the benefits gained thereby are summarized at page 9, line 8, through page 10, line 7. A far more detailed description can be found in Figs. 21-24, with corresponding description at page 42, line 8, through page 46, line 3.

All pending claims are limited by this feature. However, independent claims 1 and 11 have been herein amended to more explicitly show that the claimed "component[s]" is transferred from the claimed data base management system to the claimed "user terminal".

Clearly, Fernandez does not have this feature. Fig. 1 shows that the only transfer to application 120 is the Answer. There is no "customized user interface" as claimed and there is no

storage of "components" for a "customized user interface" stored within RDMS 110 and transferred to application 120.

Claims 16 and 21-22 have been rejected under 35 U.S.C. 102(e) as anticipated by Fernandez. This ground of rejection is respectfully traversed.

The standards for a finding of anticipation during examination are specified in MPEP 2131, which provides in part:

TO ANTICIPATE A CLAIM, THE REFERENCE MUST TEACH
EVERY ELEMENT OF THE CLAIM

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."

Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

"The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). (emphasis added)

The rejection is respectfully traversed because Fernandez does not show "the identical invention.....in as complete detail as is contained in the claims[s]". Thus, the rejection does not comply with MPEP 2131.

With regard to claim 16, the claimed "creating means" requires "defining a server request utilizing a customized user interface". There is no showing that Fernandez has the claimed "customized user interface". In fact, there is no showing that Fernandez has any "user interface" at all. The Examiner cites column 5, lines 11-15, which states:

Typically, applications contact SilkRoute 100, to request data. An application 120 only "sees" the virtual XML view.

This citation says nothing of the claimed "customized user interface".

The third element (i.e., "providing means") requires "providing a portion of said customized user interface to said creating means". In making his rejection, the Examiner finds "wherein Fernandez SilkRoute is the customized interface". In addition to being clearly erroneous, this finding makes no sense. The claim requires that the "XML document defining a service request" is created using the claimed "customized user interface" and transferred via the claimed "transmitting means". Clearly SilkRoute is not utilized to "create" the XML query but is rather used to convert the XML query to SQL (see Fig. 1). Furthermore, if SilkRoute actual were used to create the XML query, the claim requires that it be transferred using the claimed "transmitting means" which in Fernandez is only coupled to application 120.

In addition, RDMS 110 of Fernandez only provides data (i.e., "tuple stream") as clearly shown in Fig. 1. There is no showing that RDMS 110 of Fernandez "providing a portion of said customized user interface to said creating means". RDMS 110 provides only data in response to the SQL query.

The fourth claimed element is a "composing means" which the Examiner finds to be SilkRoute 100. Having found SilkRoute 100

to correspond to the claimed "customized user interface", it is contrary to controlling law for the Examiner to also find that SilkRoute 100 is the claimed "composing means".

The rejection of claim 16 and all claims depending therefrom is respectfully traversed for failure of Fernandez to meet the requirements of MPEP 2131.

With regard to claim 21, the Examiner somehow finds the claimed "user terminal". It appears that the Examiner equates "application 120" of Fernandez (i.e., clearly a software element) to be the claimed "user terminal" (i.e., a piece of hardware). Furthermore, application 120 cannot have a "customized user interface" as claimed, because there is no showing that application 120 has or could have a "user".

In attempting to find the second element (i.e., "legacy data base management system....which stores components of said customized user interface....), the Examiner states:

....and the merged XML templates and tuple streams is (sic) returned to the application is equivalent to the Applicant's said legacy database management system....which stores components of said customized user interface and which transfers said components of said customized user interface to said user terminal for generating said service request..... (emphasis added)

This statement has a number of aspects (emphasized above) which are clearly erroneous. The only thing returned to application 120 is an XML document called "answer" (see Fig. 1). The "XML templates" and "tuple stream" are only present in SilkRoute which

produces the XML document (answer) for transfer to application 120.

In addition, Fernandez cannot transfer the "components of said customized user interface to said user terminal for generating said service request", because the only transfer to application 120 is the "answer". Even more significant, there is no transfer to application 120 until after the "answer" to the query has been generated. It is inconceivable that a transfer to application 120 after performance of the query could somehow "generate said service request" as claimed.

The rejection of claim 21, and all claims depending therefrom, is respectfully traversed because Fernandez does not meet the requirement of MPEP 2131 to show "the identical invention" "in as complete detail as is contained in the claim".

Claim 22 depends from claim 21 and further limits the claimed "XML message" generated by the claimed "user terminal" utilizing the claimed "customized user interface" consisting in part from the claimed "components" stored within the claimed data base management system. As explained above, Fernandez does not have the claimed "user terminal", the claimed "XML message", the claimed "customized user interface" or the claimed "components". Therefore, Fernandez cannot have the further limitations of claim 22. The rejection of claim 22 is respectfully traversed.

Claims 1-15 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Fernandez in view of U.S. Patent No. 6,732,095, issued to Warshavsky et al (hereinafter referred to as "Warshavsky"). This ground of rejection is respectfully traversed for failure of the Examiner to present a *prima facie* case of obviousness as specified by MPEP 2143.

To make a *prima facie* case of obviousness, MPEP 2143 requires the Examiner to provide evidence and argument showing: 1) motivation to make the alleged combination; 2) reasonable likelihood of success of the alleged combination; and 3) all claimed elements within the alleged combination. The Examiner has failed to make any of these three required showings. Therefore, because the Examiner has not made a *prima facie* case of obviousness, Applicants need not and indeed cannot offer appropriate evidence and argument in rebuttal.

In an apparent attempt at showing motivation in rejecting claim 1, the Examiner states:

It would have been obvious to one having ordinary skill in the art at the time of the applicant's invention was made to combine the teaching of Warshavsky with Fernandez reference because both references are devoted to XML documents and relational database data conversions and the combined reference would have enabled a complete web-based system to invoke a seamless bi-direction flow of XML documents between application and database. Further the system would have been enhanced with composite query composition capability to efficiently transform data between relational and XML representations. (Emphasis added)

In other words, the Examiner states that a reader of Fernandez would be motivated to combine the teaching of Warshavsky to provide: 1)bi-directional flow of XML documents between application and database; 2)composite query composition capability; and 3)efficiently transform data between relational and XML representations. However, Fernandez already claims to have these features. Therefore, these three capabilities alleged by the Examiner to be added to Fernandez by the alleged combination with Warshavsky is specious.

Fig. 1 of Fernandez clearly shows bi-directional flow of XML documents in that the query transferred from application 120 is an XML document, and the answer transferred to application 120 is an XML document. Similarly, column 11, lines 19-20, states:

....takes an XML document as an input and returns an XML document.

Therefore, one would not be motivated to combine Warshavsky with Fernandez to add "bi-directional flow of XML documents" because Fernandez teaches this feature.

Similarly, Fernandez already teaches "composite query composition" (see column 11, line 15, through column 12, line 31). Therefore, one would not perform the alleged combination of Warshavsky with Fernandez to add "composite query composition capability" to Fernandez which already has this capability.

Finally, one would not be motivated to combine Warshavsky with Fernandez to permit Fernandez to "efficiently transform data

between relational and XML representations", because Fernandez already claims to teach this feature. The Abstract begins:

A method for converting relational data to XML (Extensible Markup Language) is provided. The method, sometimes referred to as SilkRoute, provides a general, dynamic, and efficient tool...

There is simply no motivation to combine Warshavsky with Fernandez to provide Fernandez with features which it already claims to have.

Though specifically required by MPEP 2143, the Examiner ignores his obligation to show reasonable likelihood of success of the alleged combination of Fernandez and Warshavsky.

The alleged combination also does not meet the third requirement of MPEP 2143 to show all of the claimed elements. As explained above, Fernandez does not have the claimed "user terminal" notwithstanding the Examiner's clearly erroneous assertion that the software application 120 of Fernandez is somehow a hardware "user terminal".

Similarly, for the reasons stated above, Fernandez has no "customized user interface" because Fernandez has no user. Furthermore, there is certainly no showing that a portion of the claimed "customized user interface" is stored within the claimed "user terminal" and another portion is transferred from the claimed "data base management system". Perhaps realizing that Fernandez lacks these claimed elements, the Examiner makes the confusing statement:

....SilkRoute is the interface having XML templates stored within and tuple streams transmitted from a database server to produce an XML document is equivalent to the Applicant's customized user interface
.....

If SilkRoute is the claimed "customized user interface" (which makes no sense), then there is no transfer to it from RDMS 110 via a "publicly accessible digital data communication network" as claimed (see Fig. 1).

Having clearly erroneously found that SilkRoute is the claimed "customized user interface", the Examiner makes the specious argument that SilkRoute generates the XML document of claim element b, which "contains said service request". However, the only XML document generated by SilkRoute is an "answer", and never a query. Therefore, the Examiner makes the disingenuous statement:

However, Warshavsky teaches XML document be (sic)
"transferred from said user terminal to said data base management system which contains said service request"
(See col. 4, lines 65-67 and col. 5, lines 1-3....
(emphasis added)

This statement is deemed disingenuous, because no one reading the cited portion of Warshavsky (or indeed all of Warshavsky) will find the "user terminal", the "data base management system", or the "service request", which the Examiner states are taught therein.

The third element of claim 1 is "an XML mapping tree stored within said data base management system...." which is not found

in the alleged combination for two reasons. First, both Fernandez and Warshavsky employ techniques for the conversion process which do not utilize "an XML mapping tree". Second, both Fernandez and Warshavsky perform conversions external to the data base management system from processes not "stored within said data base management system" as claimed.

The rejection of amended claim 1, and all claims depending therefrom, is respectfully traversed for failure of the Examiner to make none of the three required showings of MPEP 2143.

In rejecting claim 6, the Examiner fails to show the required "motivation", but only makes the same clearly erroneous and legally inadequate statements discussed above in detail. Again, the Examiner totally ignores his obligation to show reasonable likelihood of success.

And again, the Examiner makes the same clearly erroneous findings of fact and errors of law in failing to find all of the claimed elements within the alleged combination and makes yet additional ones. He simply ignores the claimed "user terminal" because the alleged combination has no user terminal and no user. He again finds that SilkRoute is somehow the claimed "customized user interface" whereas there is no support for this finding within Fernandez. He again ignores the claimed coupling of the elements. He again misquotes Fernandez stating: "...wherein Fernandez' XML virtual view is formulated at the application".

And he again clearly erroneously finds the alleged combination to have the claimed "XML mapping tree" though neither Fernandez nor Warshavsky has such an element, because each performs the conversion using a different technique. The rejection of claim 6, and all claims depending therefrom, is respectfully traversed.

Claim 11 is an independent method claim having five basic steps. The Examiner has failed to show "motivation" for the reasons stated above. In addition, the Examiner does not even attempt to show the required reasonable likelihood of success.

The Examiner similarly does not show any of the five steps to be within the alleged combination. The first step requires "transferring" a portion of a "customized user interface" to a "user terminal". The alleged combination has no "user terminal" and has no "user". As a result, the alleged combination does not have the claimed "customized user interface", which means that the alleged combination cannot have the claimed "transferring" step. Instead, the Examiner clearly erroneously states:

....wherein Fernandez' SilkRoute combining the XML template interface with tuple streams retrieved from database for transferring to the user terminal is equivalent to the Applicant's transferring a portion of a customized user interface to a user terminal);

The Examiner completely ignores that the "customized user interface" claimed by Applicant, which requires the claimed "transferring" step, is utilized by the subsequent second claimed step to "create" the claimed "XML document" which contains the claimed "service request". The paraphrased portions of Fernandez relied upon by the Examiner are utilized to assemble the XML document containing the "answer". The alleged combination simply does not have the claimed "transferring" step, because it does not have it and could not use it.

The Examiner's response to the claimed second (i.e., "creating") step is incoherent, because the Examiner relies upon the same functionality utilized in clearly erroneously finding the first, "transferring", step.

The Examiner admits that Fernandez does not have the third, "transferring" step. Instead, he relies upon Warshavsky stating:

However, Warshavsky teaches "c. transferring said XML document defining said service request to said data base management system via a publicly accessible digital data communication network" (See Fig. 1, col. 4, lines 52-57 and col. 5, lines 4-5 and 46-54 where the metadata of XML mapping definition is stored in allocation, such as repository, and the definition is of hierarchical structure whose entities represented by one to many relationships between objects, components and fields for converting XML document into columns of a record in a relational table is equivalent to the Applicant's transferring said XML document defining said service request to said data base management system via a publicly accessible digital data communication network).

It is absolutely baffling what this statement has to do with Warshavsky and even more baffling why the Examiner would consider this statement relevant to the third, "transferring" step of Applicant's claim 11.

The fourth, "parsing" step involves the use of the claimed "XML mapping tree". The alleged combination does not have this element as explained above, because Fernandez and Warshavsky utilize different conversion techniques.

The rejection of amended claim 11, and all claims depending therefrom, is respectfully traversed for failure of the Examiner to make any of the three required showings specified in MPEP 2143.

Claims 2, 8, and 14 depend from claims 1, 7, and 13, respectively, and further limit the claimed "XML document" and "XML mapping tree". These elements are not found in the alleged combination, as explained above. Therefore, the alleged combination cannot have the further limitations of claims 2, 8, and 14. The rejection of claims 2, 8, and 14 is respectfully traversed.

Claims 3 and 13 depend from claims 2 and 12, respectively, and further limit the conversion structure. The alleged combination does not have the limitations of claims 1 and 12 from which claims 3 and 13 depend. Therefore, the alleged combination

cannot have the further limitations of claims 3 and 13. The rejection of claims 3 and 13 is respectfully traversed.

Claims 4, 7, and 12, depend from claims 3, 6, and 11, respectively, and are further limited by apparatus and method structure for storing the XML mapping tree. Because the alleged combination does not have the claimed XML mapping tree, it cannot have these further limitations. The rejection of claims 4, 7, and 12 is respectfully traversed.

Claim 5 depends from claim 4 and is further limited by transferring the XML mapping tree to the claimed user terminal. The Examiner admits that the alleged combination does not have this limitation. Contrary to controlling law, he appears to rely for this element upon some document not properly cited and apparently not properly of record. Therefore, the rejection of claim 5 is respectfully traversed for being improper as a matter of law.

Claims 9 and 15 depend from claims 8 and 14, respectively, and further limits the network which couples the claimed elements in a particular manner. As explained above, the alleged combination does not have the claimed elements or the claimed coupling thereof. Therefore, it is legally irrelevant that the alleged combination parenthetically mentions the "Internet". The rejection of claims 9 and 15 is respectfully traversed.

Claim 10 depends from claim and is further limited by "wherein said XML mapping tree is hierarchical". Notwithstanding the admission on page 10 of the pending official action that "Fernandez does not explicitly teach "e. an XML mapping tree...", the Examiner attempts to imply that Fernandez has the claimed "hierarchical" XML mapping tree. The rejection of claim 10 is respectfully traversed.

Claims 17 and 24 depend from claims 16 and 23, respectively, and are further limited by storage for the "parsed document" and "XML mapping tree", respectively. The Examiner does not even address the limitations of claim 17. Furthermore, the alleged combination does not have an XML mapping tree as explained above and therefore cannot have the further limitations of claim 24. The rejection of claims 17 and 24 is respectfully traversed.

Claim 18 depends from claim 17 and further limits the claimed "XML mapping tree". The Examiner admits that Fernandez does not have an "XML mapping tree". Therefore, it is disingenuous for the Examiner to allege that Fernandez has these further limitations to the claimed "XML mapping tree". The rejection of claim 18 is respectfully traversed.

Claim 20 depends from claim 19 and further limits the XML mapping tree. The Examiner admits that the alleged combination does not have these further limitations. Instead, he cites, without legal authority, a reference not properly of record. The

rejection of claim 20 is respectfully traversed as inconsistent with controlling law.

Claims 19 and 25 depend from claims 18 and 24, respectively, and further limits the network which couples the claimed elements in a particular manner. As explained above, the alleged combination does not have the claimed elements or the claimed coupling thereof. Therefore, it is legally irrelevant that the alleged combination parenthetically mentions the "Internet". The rejection of claims 19 and 25 is respectfully traversed.

Claim 23 depends from claim 22 and further limits the claimed "conversion facility". As explained above, the alleged combination does not have the claimed "conversion facility". Therefore, the alleged combination cannot have these further limitations. The rejection of claim 23 is respectfully traversed.

Having thus responded to each objection and ground of rejection, Applicants respectfully request entry of this amendment and allowance of claims 1-25, being the only pending claims.


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Respectfully submitted,

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